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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,419	09/23/2003	Yuval Berenstein	2960/1	1092

7590 09/06/2006

DR. MARK FRIEDMAN LTD.

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Discovery Dispatch

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

**Advisory Action**  
**Before the Filing of an Appeal Brief**

Application No.

10/667,419

Applicant(s)

BERENSTAIN ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 18 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

### CONTINUATION SHEET

Continuation of item 11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The examiner's position, set forth in the prior Office action, holds that, because the WO reference teaches the production of decorative laminates, this would have suggested application of the dyes and pigments in any suitable and aesthetically desirable fashion and doing so would have been obvious to one of ordinary skill in the art. Further, the examiner's position holds that there is no evidence of record that the binder applicator taught by the WO document requires 100% coverage.

The examiner agrees with applicant's assessment of the WO reference insofar as non-wovens are taught in relation to the underlay, overlay, and/or substrate, but not the decorative layer. It is noted that, with respect to the overlay, this reference teaches:

...the overlay should preferably be transparent so that the image of the decorative layer will transmit as intended.<sup>1</sup>

It is further noted that, with respect to the underlayer, this reference teaches:

Clarity is not essential in the underlayer, so long as there is no undesired transmittance through the decorative layer.<sup>2</sup>

Finally, with respect to both the underlayer and the overlay, this reference teaches:

For example, a colorant, such as a dye or a pigment, in addition to be [*sic*] optionally added to the white-water, can be added in a separate step, for example, above 7 by use of an applicator, such as a binder applicator.<sup>3</sup>

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<sup>1</sup> 6:29-31, emphasis added

<sup>2</sup> 9:24-26, emphasis added

<sup>3</sup> 19:14-17

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In the first two passages cite above, the examiner notes use of the qualifying language “preferably” and “not essential.” It is preferable, but not required, that the overlay be transparent. Further, it is preferable, not required, that the underlayer be clear, as long as there is no undesired transmittance of the underlayer’s color and/or design through the decorative layer.

Applicant is reminded that the finished product of the WO reference is a decorative laminate. The mere fact that the finished product is decorative in nature makes the kind and degree of decoration subjective to the desire of the artisan. There is nothing in the WO reference limiting the kind and degree of decoration in any way. The only decoration explicitly disclosed by the reference, such as a wood-grain appearance [3:28-29], are exemplary and non-limiting [see also 1:7-13 and 3:20-29]. Applicant is reminded: that references are part of the literature of the art, relevant for all they contain; that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments; and that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.<sup>4</sup> Consequently, in the production of a decorative laminate in which the artisan intends for the decorative layer to transmit only partially through the overlay, application of a suitable amount and distribution of dye/pigment to the overlay (i.e., in an amount of less than 100%) would have been well-within the scope of what is suggested by the broad disclosure of the WO reference. Similarly, in the production of a laminate in which the artisan desires transmittance of a certain color and/or pattern of the underlayer through the decorative layer, application of a suitable amount and distribution of

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<sup>4</sup> MPEP § 2123

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dye/pigment to the underlayer (i.e., in an amount of less than 100%) would have been well within the scope of what is suggested by the broad disclosure of the WO reference. Applicant is further reminded that the issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art.<sup>5</sup>

Finally, applicant is reminded of the definition appearing at page 10 of the instant specification:

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The term "finishing agent" is herein used to refer to  
any additive, coating, or colorant that may be added to non-woven fabric.

The "finishing agent," as recited in the claims, is not limited to a colorant only, but to any additive or coating. Page 19 of the WO document further discloses:

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Another optional step is to apply materials or ingredients onto the surface of the dewatered compound before, during, or after drying. For example, additives such as pigments or surface active materials may be applied to the dewatered compound 1 as it is moved along the conveyor belt 7, thereby permitting impregnation of the compound 1 before it is exposed to the drying process to form the mat 1a. The fiber reinforced polymeric substrate layer may be reinforced with additional PVC or acrylic polymer particles to improve mechanical properties.

These "additives" also meet applicant's definition of a "finishing agent." Consequently, the WO reference continues to render applicant's claimed invention obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

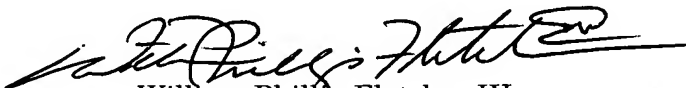
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<sup>5</sup> *In re Siebentritt*, 152 USPQ 618 (CCPA 1967)

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Philip Fletcher III  
Patent Examiner (FSA), USPTO  
Art Unit 1762

Fredericksburg, VA  
August 27, 2006